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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,245	09/08/2000	Lester D. Nelson	EXPL-01028US0 MCF/KJD	3031
23910	7590	02/20/2004	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			FOSTER, ROLAND G	
			ART UNIT	PAPER NUMBER
			2645	10

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,245

Applicant(s)

NELSON ET AL.

Examiner

Roland G. Foster

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims -15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-10, 12, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,490,343 B2 to Smith, Jr. et al. (Hereafter "Smith"), of record.

With respect to *claim 15*, see the following limitations for details on how Smith anticipates particular limitations within the claim.

The limitation "(a) a first electronic device, coupled to the telecommunication infrastructure" reads on abstract and Fig. 1a, telephone 22 which is coupled to telephone network (infrastructure).

The limitation "(b) a second electronic device, coupled to the infrastructure and remote to the first device, for storing 1) a conversation element associated with the conversation representation and 2) a software program for providing an audible utterance to the first electronic device in response to a selected conversation representation" reads on Smith as follows. A computer (second electronic device) stores correspondence data and program instructions that are downloaded to the telephone 22 (first device) via a cable or wireless link (col. 5, lines 25-30). Therefore, the computer (second electronic device) is remote to the first device. The correspondence data comprises codes that identify the actual messages (col. 5, lines 10-24). Therefore the correspondence data can be considered a "conversation element associated with the conversation representation" also as consistent with applicant's specification (page 15). The correspondence data also includes the actual messages themselves (col. 13, lines 22-28). Therefore, the computer (processing device) also comprises software sufficient to provide the actual messages (audible utterances) to the telephone (first device).

Claim 1 differs substantively from claim 15 in that claim 1 changes the terminology of one term and also introduces a new limitation. Specifically, claim 1 refers to a "processing device" that was termed a "second electronic device" in claim 15. Therefore, see the claim 15 rejection for further details regarding how the newly termed "processing device" is also anticipated by the same computer of Smith. In addition, claim 15 recites an additional limitation directed to "(b) a second electronic device, coupled to the infrastructure, for providing a conversation representation." This limitation reads on Smith as follows. A telephone 10 (second electronic device) is also coupled to the infrastructure. During a call, a user at telephone

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10 transmits a code corresponding to a message (conversation representation) (Fig. 1c and col. 10, lines 1-25).

With respect to claims 2 and 4, the signal is DTMF (in-band) (col. 10, lines 1-12).

With respect to claim 5, Smith discloses that the representation may be symbolic, a graph, and a graphic buttons (col. 7, lines 30-37).

With respect to claims 6-9, see col. 11, lines 34-55.

With respect to claim 10, see col. 7, lines 1-5.

With respect to claim 12, the processing device relays messages between the telephones.

With respect to claim 14, see col. 7, lines 1-5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claim 1 above.

Although Smith discloses that the device is connected to both a telephone network as discussed above and a computer data network (col. 5, lines 28-56), Smith fails to disclose that the signaling is "out of band" or that the device is connected to the Internet.

However, "Official Notice" was taken in the last Office action that both the concept and advantages of out of band signaling would have been well-known and accepted in the art of

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telephone systems, especially when establishing Integrated Services Digital Network (ISDN) connections or the like to a computer data network such as the Internet. The applicant's lack of traverse is taken as an admission of the facts noticed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add an ISDN connection with out of band signaling establishing both telephone and Internet connections to the system of Smith which discloses both telephone and computer data network interfaces.

The suggestion/motivation for doing so would have been to increase the bandwidth and flexibility of a computer data network connection by connecting to the ISDN which provides high bandwidth and routing flexibility (using out of band signaling) as is well-known in the art. In addition, the use of the Internet to carry data would have reduced cost and increased reliability also as well known in the art.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claim 1 above, and further in view of U.S. Patent No. 6,389,114 B1 to Dowens et al. ("Dowens"), as used in the prior Office action.

Smith fails to disclose that the device provides utterances during a conference call.

However, Dowens (similarly to Smith) teaches of a relay device that also relays the messages during a conference (abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art to add conferencing capability as taught by the relay device of Dowens to the relay device disclosed by Smith.

The suggestion/motivation for doing so would have been to increase the flexibility and efficiency of the telephone communications system by allowing multiple participants to conference together during a single call instead of requiring each party to establish point to point calls when information is exchanged. In addition, such a modification would have conformed to telephone industry standard support for conferencing capability especially in a business environment.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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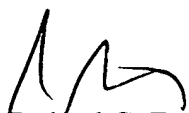
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Patent Examiner
February 13, 2004